



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/776,578	02/03/97	HARREUS A	R45073

12M1/0515
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EXAMINER
O SULLIVAN, P

ART UNIT	PAPER NUMBER
1209	4

DATE MAILED: 05/15/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/776,578

Applicant(s)

Harreus et al.

Examiner

Peter G. O'Sullivan

Group Art Unit

1209



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 11-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

1. Claims 11-17 are pending in this application which should be reviewed for errors.

Claims 1-10 have been cancelled by applicants. Applicants are requested to sent a copy of the ACS Symposium Ser. mentioned as the D3 reference in the parent PCT application and on page 2 of applicants' specification.

2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 17 recites the limitation "without a solvent" in line 2. There is insufficient antecedent basis for this limitation in claim 1. It is recommended applicants include the term, "comprising" in claim 1 to allow for this further limitation.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

Art Unit:

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the teaching of the American Chemical Society (ACS Symposium Series 443, 1991, Chapter 18, pages 226-235) in view of Hong et al. The American Chemical Society reference discloses reacting acetone oxime and ethylene carbonate in toluene in the presence of potassium fluoride or tetramethylammonium chloride to yield the corresponding oximeglycol. The instant invention differs in that additional oximes and carbonates may be used, in that additional catalysts may be used and in that the reaction may be conducted in the absence of a solvent. Regarding the use of further reactants, the use of different, but analogous reactants in an old process does not render the process unobvious. In re Durden et al. 226 U.S.P.Q. 359. The use of applicants' specific catalysts is held to be obvious in view of the fact that the use of potassium salts and basic organic nitrogen compounds are already used as catalysts in the primary reference. Hong et al. discloses that a similar reaction may be conducted in the absence of a solvent. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of the cited references, to make applicants' processes and to expect to make O-(2-hydroxyalkyl)oximes.

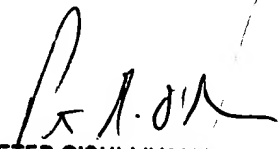
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by the American Chemical Society (ACS Symposium Series 443, 1991, Chapter 18, pages 226-235). The American Chemical Society reference discloses reacting acetone oxime and ethylene carbonate in toluene in the presence of potassium fluoride or tetramethylammonium chloride to yield the corresponding oximeglycol.
8. No claim is allowed in the absence of a clear deliniation of appicants' claims from prior art processes and a showing of unexpected beneficial results in a comparison with the closest prior art. Applicants are encouraged to place limitation in their generic claims to distinguish their claims from the prior art processes and which may serve as a basis for comparison in any showing.
9. Any inquiry concerning this communication should be directed to Peter O'Sullivan at telephone number (703) 308-4526.


PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200